



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/848,583 | 05/03/2001 | Wolfgang Matthes | A-2820 | 8707 |

24131 7590 05/09/2007
LERNER GREENBERG STEMER LLP
P O BOX 2480
HOLLYWOOD, FL 33022-2480

| |
|----------|
| EXAMINER |
|----------|

PRONE, JASON D

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3724

| | |
|-----------|---------------|
| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

05/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/848,583

Applicant(s)

MATTHES ET AL.

Examiner

Jason Prone

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3724

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

In this case, the duty to disclose incorporates the incorrect statement "material to the examination of this application under 37 C.F.R. 1.56a". The correct duty to disclose statement is as follows:

"I acknowledge the duty to disclose information which is material to patentability of this application in accordance with Title 37, Code of Federal Regulations Section 1.56."

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6, 7, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (4,922,773) in view of Besemann (4,523,502). In regards to claim 1, Ito discloses the invention including a transport device (53) having a course of motion (Fig. 4), a first drive for driving the transport device (57), a stroke device (14 and 24) for

Art Unit: 3724

moving knives (13 and 23) in a knife motion for performing the trimming of the margins (Column 8 lines 20-25), a second drive for driving the stroke device (Drive mechanism (not shown) in Column 8 lines 20-21), and the first drive and the second drive being separate (57 is clearly independent from Drive mechanism (not shown)).

In regards to claims 2 and 3, Ito discloses the cutting device is capable of trimming margins of joined/stitched-together sheets of paper (7).

In regards to claim 4, Ito discloses the control system includes a first and second control unit (Fig. 6), the first drive being linked to the first control unit (Fig. 6), a second drive being linked to the second control unit (Fig. 6), and a connection linking the first control unit to the second control unit (73).

In regards to claims 6 and 7, Ito discloses the first drive is connected by the first control unit and the second drive by the second control unit to a machine control unit (74) and the machine control unit had a human-machine interface (71 and 72).

In regards to claim 10, the drives are motors (57 and drive mechanism) and at least one of the control units has a programmable logic controller (75 and 76).

Ito discloses 2 separate drives and it could be assumed that the entire apparatus including the 2 separate drives are controlled by one central computer or power source especially since the cutter must be synchronized with the conveyor; however Ito fails to disclose this fact and therefore fails to disclose both drives being connected to the other via a control system for setting the course of motion of the transport device to the knife motion as a function of product format.

Besemann teaches it is old and well known in the art of tools that include a transfer drive and a cutter drive to incorporate both drives being connected to the other via a control system for setting the course of motion of the transport device to the knife motion as a function of product format (Column 2 lines 30-37). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have provided Ito with one control for both drives, as taught by Besemann, to allow both drives to be controlled from the same station.

4. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito in view of Besemann as applied to claims 1 and 4 above, and further in view of Cannon et al. (4,553,080). Ito in view of Besemann disclose the invention including the first and second drives are motors (57 and drive mechanism in Ito).

However, Ito in view of Besemann fail to disclose position transducers connected to the first control unit and drive and to the second control unit and drive. Cannon et al teaches that it is old and well known to exchange encoders for position transducers (Background of the Invention). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Ito in view of Besemann with position transducers instead of encoders, as taught by Cannon et al., to provide more a less complex and cheaper apparatus.

Response to Arguments

5. Applicant's arguments with respect to claim 1 (both drives connected via a control system) have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3724

6. Applicant's arguments filed 27 February 2007 have been fully considered but they are not persuasive with regards to Ito not meeting the stroke device limitation. The term "stroke device" is very broad and can be interpreted as any structure associated with a stroke movement. Cutters 12 and 22 clearly are moved from a top position to a bottom position that defines the stroke (column 3 lines 50-53). Item 14 and 24 hold the blades while they move from one position to the other making items 14 and 24 part of the structure associated with moving the blades. Without 14 and 24 the blades could not be connected to the apparatus and therefore could not perform a stroke or moving function. Items 14 and 24 allow the blades to perform a stroke movement and are therefore considered stroke devices. Applicant must disclose additional structure to prevent the examiners interpretation of the term stroke device.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 7:00-4:30, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

May 04, 2007

A handwritten signature in black ink, appearing to read "Jason Prone", with a stylized flourish at the end.

Patent Examiner
Jason Prone
Art Unit 3724
T.C. 3700